



**IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE**

Serial No. : 09/925,673  
Applicant(s): Masakatsu KANEKO et al.  
Filed : August 9, 2001  
For : NOVEL NUCLEOSIDE AND  
OLIGONUCLEOTIDE ANALOGUES  
Art Unit : 1623  
Examiner : Howard Owens, Jr.  
Docket No. : 01376CIP/HG  
Customer No.: 01933  
Confirmation No.: 4630

**REQUEST FOR FULLY INITIALED COPIES  
OF FORMS PTO/SB/08A AND PTO/SB/08B  
AND REQUEST FOR CORRECTED FORM PTO-892**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

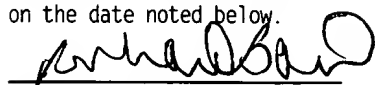
S I R :

A. The Office Action of July 29, 2003 returned a copy of applicants' Form PTO/SB/08B (6 sheets dated November 7, 2001) with the Examiner's initials in the left column next to each of the cited publications, except for the following two publications, which the Examiner drew lines through:

MARTIN, "A New Access to 2'-O-Alkylated Ribonucleosides and Properties of 2'-O-Alkylated Oligoribonucleotides", Helv. Chim. Acta., 1995, Vol. 78, pp. 486-504 (cited on sheet 2 of the Form PTO/SB/08B dated November 7, 2001); and

**CERTIFICATE OF MAILING**

I hereby certify this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to:  
Commissioner for Patents,  
P.O. Box 1450  
Alexandria, VA 22313-1450  
on the date noted below.

  
Attorney: Richard S. Barth

Dated: August 20, 2003

In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by check attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper, to Account No. 06-1378.

GP. 16234  
RECEIVED  
AUG 27 2003  
TECH CENTER 1600/2900

HEGEMANN et al., "BIOCHEMICAL PHARMACOLOGY OF PROTEIN KINASE C AND ITS RELEVANCE FOR DERMATOLOGY", Pharmacol. of the Skin, 1992, Chapter 22, pp. 357-368 (cited on sheet 6 of the Form PTO/SB/08B dated November 7, 2001).

No reasons were set forth in the July 29, 2003 Office Action as to why the above two publications were not initialed by the Examiner.

The MARTIN publication is in German, but includes on the first page thereof an English-language abstract which is reproduced as follows:

"A New Access to 2'-O-Alkylated Ribonucleosides and Properties of 2'-O-Alkylated Oligoribonucleotides

A general access to 2'-O-alkylated ribonucleosides using the key intermediate 5 is presented. The incorporation of 2'-O-ethyleneglycol- and 2'-O-glycerol-substituted (i.e., 2'-O-(2-hydroxyethyl)- and 2'-O-(2,3-dihydroxypropyl)-substituted) ribonucleosides into oligonucleotides affords a new generation of oligonucleotides with high affinity for RNA, high specificity, and increased nuclease resistance."

The MARTIN publication is also discussed in the paragraph bridging pages 11 and 12 of the specification as follows:

"Preferred 2'-groups of the sugar include H, OH, F, and O--, S--, or N-alkyl groups. One particularly preferred group includes 2'-methoxyethoxy[2'--O--CH<sub>2</sub>CH<sub>2</sub>OCH<sub>3</sub>, also known as 2'-O-(2-methoxyethyl) or 2'-

MOE] (Martin et al., Helv. Chim. Acta., 1995, 78, 486), i.e., an alkoxyalkoxy group."

It is respectfully submitted that the above information concerning the MARTIN publication provides a concise explanation of the relevance of the MARTIN publication (37 CFR 1.98(a)(3)(i)).

The HEGEMANN et al. publication is Chapter 22 in a book entitled "Pharmacology of the Skin", edited by Hasan Mukhtar. It is considered that the Examiner did not realize that HEGEMANN et al. was included in this book. A copy of the HEGEMANN et al. publication is enclosed for the convenience of the Examiner.

In view of the above, it is respectfully requested that the Examiner provide the undersigned with fully initialed copies of sheets 2 and 6 of the Form PTO/SB/08B dated November 7, 2001.

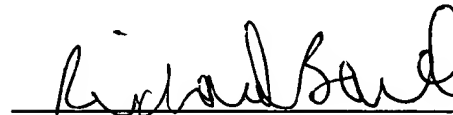
B. The Examiner is respectfully requested to return to the undersigned fully initialed copies of the Forms PTO/SB/08A and PTO/SB/08B filed on June 5, 2003.

C. The July 29, 2003 Office Action included a Notice of References Cited (Form PTO-892) which cited "WO 98/39532" to Imanishi et al. This citation is incorrect. The correct citation is "WO/39352" (see sheet 1 of applicants' Form

PTO/SB/08A dated October 31, 2001). Please correct the Patent Office records accordingly, and please issue a corrected Form PTO-892.

Frishauf, Holtz, Goodman  
& Chick, P.C.  
767 Third Ave., 25th Floor  
New York, NY 10017-2023  
Tel. Nos. (212) 319-4900  
(212) 319-4551/Ext. 219  
Fax No.: (212) 319-5101  
E-Mail Address: BARTH@FHGC-LAW.COM  
RSB/ddf

Respectfully submitted,

  
Richard S. Barth  
Reg. No. 28,180

Enc.: copy of HEGEMANN et al., "BIOCHEMICAL PHARMACOLOGY OF PROTEIN KINASE C AND ITS RELEVANCE FOR DERMATOLOGY", Pharmacol. of the Skin, 1992, Chapter 22, pp. 357-368